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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,531	08/28/2003	Tobias Horngren	14069.2US01	9032
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MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				BOSWELL, CHRISTOPHER J
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/650,531	HORNGREN ET AL.	
	Examiner Christopher Boswell	Art Unit 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 October 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-7,9-29,31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-7,9-29,31 and 32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 August 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

Ownership

Claims 1, 3-7, 9-29 and 31-32 are directed to an invention not patentably distinct from claims 1-11 of commonly assigned patent 7,100,402 to Holmgren. Specifically, U.S. Patent Number 7,100,402 discloses a security device for holding items having a first security member, a second security member, where the first and second security members are engaged at a closed position to retain the item, a lock slide mounted to the first security member and displaceable while remaining mounted to the first security member and a latch for maintaining the lock slide in a locked position, the lock slide comprising a spring blade configured to engage with a stop member, where the spring blade is arranged on the second security member and the stop member is integral to the lock slide. Claims 1-11 do not disclose the spring blade forming an integral part of the lock slide and the stop member being arranged on the second security member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to reverse the locations of the spring blade and the stop member, where the spring blade would extend from a principal plane of the lock slide, and the stop member would be a shoulder portion of a recessed portion on the second security member, since it has been held that a mere reversal of essential working parts of a device involves only routine skill in the art

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned patent 7,100,402 to Holmgren, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as

prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-7, 9-29 and 31-32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 7,100,402. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent Number 7,100,402 discloses a security device for holding items having a first security member, a second security member, where the first and second security members are engaged at a closed position to retain the item, a lock slide mounted to the first security member and displaceable while remaining mounted to the first security member and a latch for maintaining the lock slide in a locked position, the lock slide comprising a spring blade configured to engage with a stop member, where the spring blade is arranged on the second security member and the stop member is integral to the lock slide. Claims 1-11 do not disclose the spring blade forming an integral part of the lock slide and the stop member being arranged on the second security member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to reverse the locations of the spring blade and the stop member, where the spring blade would extend from a principal plane of the lock slide, and the stop member would be a shoulder portion of a recessed portion on the second security member, since it has been held that a mere reversal of essential working parts of a device involves only routine skill in the art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 9-29, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 7,100,402 to Holmgren.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Holmgren discloses a security device for retaining items having a first security member (10) and a second security member (11), wherein the first and second security members are engaged at a closed position for retaining an item, a lock slide (15) mounted to the first security member (abstract, lines 2-4) and displaceable while remaining mounted to the first security member between an unlocked position wherein the security device can be opened and a locked position (figure 4) for maintaining the security device in the closed position, and a latch (25 and

27) including a spring blade (26) configured to engage with a stop member (28) for maintaining the lock slide in the locked position, wherein the spring blade comprises a magnetic resilient material (column 3, lines 39-41), the spring blade forms an integral part of the second security member (figure 3), and the stop member is arranged on the lock slide (figure 3), as in claim 1. However, Holmgren does not disclose the spring blade being on the lock slide and the stop member being on the second security member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to reverse the locations of the spring blade and the stop member, where the spring blade would extend from a principal plane of the lock slide, as in claim 3, where the spring blade would be configured to engage the stop member, in the locked position, as in claim 4, wherein the stop member would be a shoulder portion of a recessed portion on the second security member, as in claims 5 and 6, since it has been held that a mere reversal of essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. The reversal of the components would be utilized for the purpose of providing a satisfactory protection against theft of the objects displayed in the container where it is difficult to opened by means of a tool (column 1, lines 33-38).

Holmgren also discloses the security device having a plurality of spring blades and a plurality of corresponding stop members, spaced apart along the lock slide (figure 3), as in claim 7, as well as the lock slide having a protruding tooth (20), the tooth engages with a projecting tab (tab defined between the slots 23A and 23B) on the second security member in the locked position, as in claim 9, wherein the tooth is bent out portion of the lock slide, and protruding from a principal plane of the lock slide (figure 5), as in claim 11, and a plurality of teeth and tabs are provided (figures 3 and 5), spaced apart along the lock slide, as in claim 12, as well as the

first security member has a first projecting tab (19), and the second security member has a second projecting tab (tab defined between 23A and 23B), wherein the second projecting tab passes adjacent to the first tab when assuming the closed position (figure 5), wherein the lock slide has a protruding tooth (20) assuming a position between and at least partly overlapping the first and second tabs in the locked position (figure 5), as in claim 10.

Holmgren further discloses the security members are configured to completely enclose a retained item in the closed position (column 2, lines 52-64), as in claims 13 and 14, where the security members are joined and locked to each other at respective first ends (figures 2 and 8-10), and are hinged together (column 3, line 62-column 4, line 11) at respective second ends opposite the first ends, as in claim 15, as well as the security members are joined and locked to each other at respective first ends (figures 2-4), and adapted to be hooked together (hooked together by hinge 29 and 30) at respective second ends opposite the first ends, as in claim 16, and where the security members are joined and locked to each other at respective first ends, and at respective second ends opposite the first ends (figure 4 and hinge 29 and 30), as in claim 17.

Holmgren additionally discloses the first security member is a base member and the second security member is a lid member, wherein the base and lid members form a box-like structure in the closed position (figure 2), as in claim 18, wherein the base member has a front wall (12) carrying the lock slide on an inner side thereof, and the lid member has a front wall (22) positioned on an inner side of the lock slide in the locked position, as in claim 19, as well as the lid member having a flange (the upwardly projecting flange that engages element 12; figure 4) projecting from the front wall thereof, wherein the flange in the closed position engages with the front wall of the base member and encloses the lock slide in the box-like structure (figure 4),

as in claim 20, and where the lock slide further comprises a maneuver means (16) projecting through an aperture (18) in a side portion of the first security member, as in claim 21, and further comprising an alarm tag (column 4, lines 58-62), as in claim 22.

Holmgren also discloses a security device for holding items, having a first security member (10) and a second security member (11), wherein the first and second security members are engaged at a closed position for retaining an item (column 2, lines 52-64), a lock slide (15) mounted to the first security member (abstract, lines 2-4) and including a stop member (28) and displaceable while remaining mounted to the first security member (figure 3) between an unlocked position wherein the security device can be opened and a locked position for maintaining the security device in the closed position (figure 4), and a latch (26) for maintaining the lock slide in the locked position, wherein the latch is carried on the first security member (figure 3), and is configured to engage with the stop member in the locked position (figure 3), as in claim 23. However, Holmgren does not disclose the spring blade being on the lock slide and the stop member being on the second security member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to reverse the locations of the latch means and the stop member, wherein the stop member would be a shoulder portion that would be a recessed portion on the second security member, as in claims 28 and 29, and where the latch would be integral with the lock slide, as in claim 25, since it has been held that a mere reversal of essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. The reversal of the components would be utilized for the purpose of

providing a satisfactory protection against theft of the objects displayed in the container where it is difficult to opened by means of a tool (column 1, lines 33-38).

Holmgren further discloses the latch means comprising a spring blade (26) extending from a principal plane of the lock slide, as in claim 24, and where the spring blade is configured to engage with the stop member (figure 3) in the locked position, as in claim 26, as well as the latch means having a plurality of spring blades and a plurality of corresponding stop members, spaced apart along the lock slide (figure 3), as in claim 27, as well as the security device having an alarm tag (column 4, lines 58-62), as in claim 31, wherein the latch comprises a resilient magnetic material (column 3, lines 39-41), as in claim 32.

Response to Arguments

Applicant's arguments filed October 3, 2007 have been fully considered but they are not persuasive. In regards to the argument that the reference is not available as prior art because the reference and the claimed invention of the present application were, at the time the invention was made, owned by the same person or entity, or subject to an obligation of assignment to the same person or entity, the examiner points to the fact that a mere allegation is not enough to show proof that the applied reference and the current invention were commonly owned at the time the invention was made. The applicant must either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Boswell whose telephone number is (571) 272-7054. The examiner can normally be reached on 9:00 - 4:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Engle can be reached on (571) 272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher Boswell
Examiner
Art Unit 3673

CJB *CB*
December 6, 2007



PATRICIA ENGLE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600